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EXAMINER

SALUJA, DALPREET S

ART UNIT PAPER NUMBER

3622

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/672,294	Applicant(s) ANAND ET AL.	
	Examiner Dalpreet S. Saluja	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-34 is/are rejected.
- 7) ☒ Claim(s) 20 and 29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/4/2005; 7/15/2005</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The Information Disclosure Statements filed on **13 January 2003, 04 March 2005, and 15 July 2005** have been considered. An initialed copy of the Form 1449 is enclosed herewith.

Status of Claims

2. This action is in reply to the non-provisional application filed on **26 September 2003**.
3. **Claims 17-34** have been added by preliminary amendment filed on 01 August 2006.
4. **Claims 1-16** have been canceled by preliminary amendment filed on 01 August 2006.
5. **Claims 17-34** are currently pending, have been examined, and are ***rejected***.

Non-Compliant Preliminary Amendment

6. The amendment to the claims filed on 01 August 2006 does not comply with the requirements of 37 CFR 1.121 because: The Amendments lack the appropriate status identifiers. See MPEP §714. The examiner assumes that the status of claims 17-34 is "New". Applicant is cautioned that future failure to properly provide status identifiers could result in delays for correction.

Claim Objections

7. **Claims 20 and 29** are objected to because of the following informalities:

- Misspelling in lines 5-7.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. **Claims 20 and 29** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recite the limitation "pre-existing content" in lines 3-7. In paragraph 0021 of the disclosure – the paragraph that seem most likely to disclose this limitation - Applicant states "sponsored content and search results are integrated so as to ensure that presentation of the integrated content and search results appears similar to the theme of the website that the user is currently viewing. Preferably, integrated content and search results should appear in the primary theme of the web page or website that the user is currently viewing." This paragraph, however, appears to have little connection to the "pre-existing content" of the instant claim. Thus, there is no support for this limitation in Applicant's disclosure.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. **Claims 17-34** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. **Claims 17, 20, 26, and 29** contain improper Markush groups. Alternative expressions are permitted if they present no ambiguity or uncertainty with respect to the question of scope or clarity of the claims. Therefore, a properly written Markush group includes the transitional phrase "consisting of" rather than "comprising" indicating that the group is a closed set. MPEP §2173.05(h). These claims include the term "comprising" or "comprises" and therefore do not follow the proper format. For purposes of this examination, the Examiner interprets these claims as requiring only one element from the set presented. Since claims 18-25 and 27 – 34 are dependent on these claims, they are rejected for the same reasons.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

14. **Claims 17, 18, 21 - 23, 25-27, 30- 32, and 34** are ***rejected*** under 35

U.S.C. 102(e) as being anticipated by Emens et al., Patent No. US 7,076,443 B1 filed on 31 May 2000 ("Emens").

15. **Claim 17 and 26:** Emens teaches:

- *storing, remote to a client, user specific data that reflects one or more user interests of a user, wherein said user specific data is collected using a search website that provides searching functionality (see at least column 2, lines 32-38)*
- *retrieving a set of sponsored content based, at least in part, on said user specific data (see at least column 2, lines 34-38 wherein the advertisements are sponsored content)*

16. Emens does not explicitly teach *integrating said sponsored content into a display generated by one of: an email client, an instant messaging client, and a website other than said search website*. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the

method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted that the prior art invention includes a graphical user interface for presentation of the products selected by the user for further searching and selection (see at least column 2, lines 61-67). Furthermore, Emens suggests that (1) the graphical user interface comes from a website (since all content transmitted through the Internet generally comes from a website) and (2) the advertisement presented is separate from the search website.

17. **Claims 18 and 27:** Emens teaches the method and machine-readable medium of Claims 17 and 26, respectively, as set forth above. Emens further teaches *wherein said user specific data includes a word or phrase upon which the user search for using said search website* (see at least column 2, lines 32-35).

18. **Claims 21, 22, 30, and 31:** Note on Optional Claim Language: Claim scope is not limited by claim language that suggests or makes optional, but does not require, steps to be performed, or by claim language that does not limit a claim to a particular structure. MPEP § 2106, RN II. In the instant case, in Claims 17 and 26 from which Claims 21 and 30 depend, Applicant provides three options for integrating the sponsored content into a display. Claims 21 and 30, however, only provides the option of integrating content into an e-mail message therefore making the other two options unnecessary. Furthermore, Claims 22 and 31, which depends from Claims 21 and 30, only recite the separation of the sponsored content from email messages, again making the other two options unnecessary. Therefore, these claims hold no patentable weight.

19. **Claims 23 and 32:** Emens teaches the method and machine-readable medium of Claims 17 and 26, respectively, as set forth above. Emens further teaches *displaying, at least a portion of, said set of sponsored content on a website other than said search website* (see at least column 5, lines 54-64 wherein a product advertisement page is formatted and displayed upon user selection).
20. **Claims 25 and 34:** Emens teaches the method and machine-readable medium of Claims 23 and 32, respectively, as set forth above. Emens further teaches *wherein the portion of sponsored content displayed on said website is a banner advertisement* (see at least column 5, lines 8-10).

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
22. **Claims 19, 20, 24, 28, 29, and 33** are ***rejected*** under 35 U.S.C. 103(a) as being unpatentable over Emens in view of McElfresh et al., Patent No. US 6,907,566 B1 filed on 2 April 1999 ("McElfresh").
23. **Claims 19 and 28:** Emens teaches the method and machine-readable medium of Claims 17 and 26, respectively, as set forth above.
- Emens does not teach *wherein said sponsored content has a higher priority on said display than other content on said display*. McElfresh

does teach such a limitation (see at least column 4, lines 33-37 wherein ads are prioritized based on click-through percentage)

- Therefore, since advertisers want to be at or near the top of a user's display in order to get their money's worth of brand recognition (see McElfresh in at least column 2, lines 1-5), it would have been prima facie obvious at the time the invention was made to have been motivated to combine the teachings of Emens, wherein a system and technique for automatically associating related advertisements to individual search results terms of a search result set is taught, with the teachings of McElfresh, wherein a method and system for optimum placement of advertisement on a webpage is taught.

24. **Claims 20 and 29:** Emens teaches the method and machine-readable medium of Claims 17 and 26, respectively, as set forth above.

- Emens does not teach *displaying said sponsored content on said display using a characteristic of pre-existing content on said display, wherein said characteristic includes one or more of the following: a design of said pre-existing content, a motif of said pre-existing content, an organization of said pre-existing content, and a layout of said pre-existing content* (see at least column 2, lines 5-9 disclosing that the trend for online advertising at the time was to direct ads to certain themes such as ads directed to younger users placed on websites relating to pop culture)

- Therefore, since a common and effective approach to online advertising is to display pre-selected advertisements for a target audience (see Emens in at least column 1, lines 33 - 36), it would have been prima facie obvious at the time the invention was made to have been motivated to combine the teachings of Emens, wherein a system and technique for automatically associating related advertisements to individual search results terms of a search result set is taught, with the teachings of McElfresh, wherein a method and system for optimum placement of advertisement on a webpage is taught.

25. **Claims 24 and 33:** Emens teaches the method and machine-readable medium of Claims 23 and 32, respectively, as set forth above.

- Emens does not teach *wherein the portion of sponsored content displayed on said website is displayed using the same design, motif, organization, or layout as other text on said website*. McElfresh does teach such a limitation (see at least column 6, lines 60-65 wherein displaying the sponsored content using the same design, motif, organization or layout as other text is a constraint on the display of the sponsored content).
- Therefore, since a common and effective approach to online advertising is displaying and targeting pre-selected advertisements to a particular audience (see Emens in at least column 1, lines 33 - 36), it would have been prima facie obvious at the time the invention was

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made to have been motivated to combine the teachings of Emens, wherein a system and technique for automatically associating related advertisements to individual search results terms of a search result set is taught, with the teachings of McElfresh, wherein a method and system for optimum placement of advertisement on a webpage is taught.

Conclusion

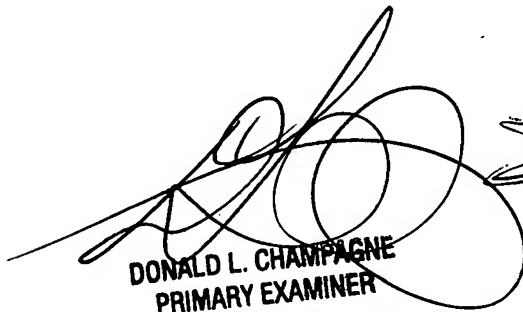
26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Boyd et al., Publication No. US 2005/0027599 A1 provisionally filed on 31 July 2003 which teaches a content delivery and storage system and method.
- Marsh et al., Patent No. 5,848,397 issued on 8 December 1998 which teaches a method and apparatus for scheduling the presentation of messages to computer users.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dalpreet S. Saluja whose telephone number is (571) 270-1834. The examiner can normally be reached on Monday-Thursday, 7:30AM-5PM est, ALT Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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